

REMARKS

This responds to the Office Action mailed on June 13, 2005, and the references cited therewith.

Claims 11 and 37 are amended, claims 1-10 were previously canceled, and no claims are added; as a result, claims 11-40 are now pending in this application.

The amendments made herein have been to clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. The amendments to the claims have support throughout the specification. No new matter has been added as a result. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

Interview Summary

The Office Action mailed on June 13, 2005 states no grounds of rejection for claims 22-40, nor are these claims listed as pending. Claims 22-40 were added in the Preliminary Amendment and Response to Restriction Requirement filed on April 7, 2005 (hereinafter "4/7/05 Communication"). Applicant's Representative, Barbara J. Clark, discussed claims 22-40 with Examiner Sameh Tawfik during a telephone interview on August 30, 2005. Examiner Tawfik acknowledged that these claims are properly pending, but have not been examined. However, in lieu of a providing a replacement or supplemental Office Action, Examiner Tawfik asked Applicant to instead respond to the outstanding Office Action. Examiner Tawfik stated that the next Office Action would address claims 21-40 and would be a non-final Office Action. Applicant thanks Examiner Tawfik for the courtesy of a telephone interview with Ms. Clark to discuss this matter.

Information Disclosure Statement

The Examiner stated that the Information Disclosure Statement filed 10/29/03 failed to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document and non-patent literature. These documents were filed in the parent case. However,

for the Examiner's convenience, copies of the three foreign patent references cited in the IDS filed 10/29/03 are provided herewith.

Election/Restriction

Applicant still does not understand why the claims are considered to be in the specific class and subclasses noted by the Examiner and seeks clarification on that point. As stated in the 4/7/05 Communication, "It is also not readily seen how class 493 (manufacturing container or tube from paper; or other manufacturing from a sheet or web) and subclass 114 (securing) applies fully and only to claims 11-15. Claims 11-15 recite "a sealed container" which, according to the specification, is not limited to paper. Claims 15-21 also recite "a sealed container" not limited to paper. Is the proposed classification a suggestion that the sealed container in claims 11-14 is limited to paper containers while the sealed container in claims 15-21 is not? If so, Applicant respectfully traverses this suggestion and again states that none of the sealed containers are limited to paper only. Class 493 otherwise includes "other manufacturing", *i.e., other than containers*, made from a sheet or web."

Applicant again respectfully requests clarification of the classes and subclasses identified herein and an explanation of how each claim set is viewed to fall into these separate classes and subclasses or otherwise requests that claims 11-14 (as well as claims 22-40) be additionally or alternatively considered to fall within class 53/subclass 412 and be examined together with claims 15-21.

§112 Rejection of the Claims

Claims 11-14 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

It is believed that the amendments made herein to the claims obviate said objections.

Reconsideration and withdrawal of these objections are respectfully requested.

§102 Rejection of the Claims

Claims 11 and 12 were rejected under 35 U.S.C. § 102(b) for anticipation by Chalin et al. (US 3,873,735). This rejection is respectfully traversed.

The Office Action asserts that Chalin teaches various elements of the claims.

Applicant respectfully submits that the Examiner has not established a *prima facie* case

of anticipation of the present claims. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.

In re Dillon, 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, A[an]ticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir.1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir.1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131 (emphasis added).

Chalin discusses a food package for heating and venting. The package has a lift tab 828 which serves as a means of grasping. The lift tab is a part of the package and is not separately secured to the bag.

In contrast, claim 11 recites a method for providing an enhanced opening system for a sealed container comprising providing a package comprising a bag having lines of weakness and a pull-tab opener secured to the bag proximate to the lines of weakness, the pull-tab opener having a pull-tab opening integral therewith, wherein the pull-tab opening is designed to be hooked with hooking means; and providing suitable markings to convey instructions to use the pull-tab opener to access package contents without utilizing a pinch force, wherein the package is adapted to be opened easily by a person who follows the instructions conveyed by the markings.

Applicant cannot find, in Chalin, a pull-tab opener secured to the bag, nor a pull-tab opening designed to be hooked with hooking means, nor instructions to use the pull-tab opener without utilizing a pinch force.

Chalin does not anticipate the claims, including unexamined claims 22-40. Applicant respectfully submits that claim 11 is allowable in its present form. Since claim 12 depends from and further defines claim 11, claim 12 is also believed to be allowable in its present form. Additionally, since unexamined claims 22-35 depend from and further define claim 11, these claims are also believed to be allowable in their present form. Similarly, Applicant respectfully

submits that claim 36 is allowable in its present form. Since claims 37-40 depend from and further define claim 36, claims 37-40 are also believed to be allowable in their present form.

Notification to this effect is respectfully requested.

§103 Rejection of the Claims

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chalin et al. (US 3,873,735) in view of Forman (US 4,679,693). This rejection is respectfully traversed.

Applicant respectfully submits that the Office Action has not established the *prima facie* obviousness of the present claims. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP 2142 (citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Furthermore, claims 13 and 14 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Chalin does not teach or suggest the claimed invention for all the reasons stated above. It is further noted that Chalin is directed to solving problems relating to heating and venting of food contents within a package.

Forman does not overcome the deficiencies of the primary reference. Forman discusses a resealable container with a tearable face opened and resealed by a label. There is no discussion of heating or venting the contents within the package.

Clearly, the product in the primary reference and each of the products in the secondary references are fundamentally different from each other and such critical differences must be recognized. In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g*

denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

Additionally, there is simply no suggestion in Chalin *as to the desirability* of providing a reusable pull-tab opener. There is further absolutely no indication of any appreciation of the problem being solved by Applicant's invention. When a person, having the references before him and not cognizant of Applicant's disclosure, would not be informed that a problem (solved by Applicant's claimed invention) ever existed, such references (which never recognized the problem) *could not have suggested its solution*. Combining references in this manner is improper. *In re Shaffer*, 229 F.2d 476, 108 USPQ 326, 329 (CCPA 1956). Focusing on the obviousness of substitutions and differences instead of on the invention as a whole is a legally improper way to simplify the difficult determination of obviousness. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 93 (Fed. Cir. 1986).

An additional requirement of the *prima facie* case is that the *references must teach or suggest all the claim limitations*. As noted above, Chalin fails to teach or suggest various elements of the claims, including, but not limited to, a pull-tab secured to the bag as well as any type of pull-tab opening designed to be hooked by hooking means as recited in the claims. Since all of the elements of the claims are not found in the references, Applicant assumes the Examiner is taking official notice of the missing elements from an undisclosed source. Applicant respectfully objects to the taking of official notice, and pursuant to MPEP 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing element, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of the claims.

Applicant respectfully submits that claims 12 and 13, as well as the unexamined claims are patentably distinct from the cited references, either alone or in combination. Claims 12-13, as well as claims 22-40, each viewed as a whole, are not suggested by the cited references and not obvious under 35 USC 103(a).

Reconsideration and withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicant again submits that the cited art does not anticipate nor render obvious claims 22-40 and that the unexamined claims are allowable in their present form. Specifically, claims 22-35 depend directly or indirectly on independent claim 11, which is believed to be allowable. Claims 36-40 are also believed to be allowable in their present form. Additionally, a new search is not required, as claim 36 does not contain any additional limitations not already considered in claim 11.

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date SEPTEMBER 12, 2005 By Barbara J. Clark
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: ~~Mail Stop Amendment~~, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12 day of September, 2005.

CANDIS BUENDING

Name

Clark
Signature